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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,278	11/02/2001	Thomas M. Jessell	40314-A/JPW/MVM	3060
7590	03/26/2004		EXAMINER	
John P. White Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			O HARA, EILEEN B	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,278	JESSELL ET AL.	
	Examiner	Art Unit	
	Eileen O'Hara	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,19,20,22-27 and 36-48 is/are pending in the application.
- 4a) Of the above claim(s) 17,20,22-27 and 36-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19,41 and 42 is/are allowed.
- 6) ☒ Claim(s) 43-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 17, 19, 20, 22-27 and 36-48 are pending in the instant application. Claims 41-48 have been amended as requested by Applicant in the Paper filed Oct. 6, 2003.

Claims 17, 20, 22-27 and 36-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the Paper filed June 30, 2003.

Claims 19 and 41-48 are currently under examination.

Election/Restrictions

2. Applicants traversal to the restriction requirement and assertion that claims 17, 19, 20, 22-27 and 36-48 define a single inventive has been fully considered but are not deemed persuasive, for reasons of record in the previous Office Action, Paper No. 9, at pages 2-4.

Priority

3. Applicants' amendment to the specification to update the status of Application 08/065,844 is acknowledged.

Drawings

4. The objection to the drawings and specification is withdrawn in view of Applicants' submission of formal drawings and Applicants' amendment to the specification.

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Objection to Specification and Claim

5. The objection to claim 41 and the objections to the specification are withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 43-48 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for reasons of record in the previous Office Action, Paper No. 9, at pages 6-9, and below.

Applicants traverse the rejection, and submit that claims 41-48, as amended, address the Examiner's rejection and satisfy the requirements of 35 U.S.C. 112, first paragraph. Applicants' amendments have overcome the rejection of claims 41 and 42, since the specification is enabling for the dorsalin-1 polypeptide to stimulate neural crest cell differentiation. However, Applicants' arguments have been fully considered but are not deemed persuasive for claims 43-48. Although the claims no longer recite a "pharmaceutical composition", the claims still encompass a composition comprising an amount of isolated dorsalin-1 polypeptide effective to regenerate a nerve cell, promote bone growth or wound healing or inhibit neural tumor cell growth in a subject, and these limitations require enablement of the claimed compound for the recited use.

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The specification is not enabling for such uses of the dorsalin-1 composition, as discussed in the previous Office Action. Therefore, the rejection is maintained.

It is believed that all pertinent arguments have been answered.

Conclusion

7.1 Claims 19, 41 and 42 are allowed.

7.2 Claims 43-48 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (571) 272-0871.

Official papers Before Final and After Final filed by RightFax should be directed to (703) 872-9306.

The customer service RightFax number is (703) 872-9305.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Eileen B. O'Hara, Ph.D.

Patent Examiner

A handwritten signature in black ink, appearing to read "Lorraine Spector". The signature is written in a cursive, flowing style with a large initial "L".

LORRAINE SPECTOR
PRIMARY EXAMINER